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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: MARTIN CULLEN
FOR: TILE WET SAW WITH OUTWARDLY DIVERGING CUTTING MODE
SERIAL NO.: 09/864,350
FILED: May 25, 2001
EXAMINER: Derris H. Banks. Primary Examiner, Art Unit 3723

Hon. Commissioner of Patents
and Trademarks
Washington, DC 20231

Sir:

This is in Reply to the Office Action of 10/22/01.

Please amend claim 1 as follows:

In line 1, before "saw" insert —ceramic tile shaping—and after "saw" delete
"capable of shaping a 6 inch square ceramic tile", and after "comprising" delete "for";

In line 2, before "a circular blade" delete "providing cutting service to said saw";

In line 7, delete "and" and "to" and after "to" insert —beneath—;

In line 8, before "having" insert —and—;

In line 9, insert —a descending movement of said housing—;

Insert as line 10 —along said path of said pivotal traversing movement effective to
establish the contacting—;

In line 11, delete "whereby said tile is adapted to be contacted" and after
"centrally of a" insert —start of a—;

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In line 12, after "during" insert —an—;

In line 13, after "descent" delete "said cut in said tile", after "tile" insert —a—, after "progressively" delete "enlarges" and after "enlarges" insert —enlargement thereof—;

In line 14, after "parts," insert —whereby said shaping is—; and

In line 15, before "in an optimum" insert —achieved—; and after "nominal time" insert —than would have entailed making said cut from one end thereof to the opposite end thereof—.

Marked up and clean versions of amended claim 1 accompany this reply.

Reconsideration of the rejection of claim 1, as amended, as unpatentable under 35 U.S.C. 102(b) over Sigetich et al. '159 is respectfully requested for the reasons which follow.

Despite the leeway of MPEP 2173.01 CLAIM TERMINOLOGY, applicant acknowledges the correctness of the examiner's position that presenting in a claim what the recited structure can do, rather than positive recitations of what it does, does not distinguish over the '159 patent. Thus, claim 1 has been amended to recite in a positive fashion the point of novelty of applicant's ceramic tile saw, namely that in applying a cut which cuts the tile in half, the cut starts in the middle and proceeds outwardly simultaneously from the middle location to the ends of the cut, which results in the cut being achieved in a significantly nominal duration, as compared to the time it takes to cut the tile in half starting from one end and proceeding along the length of the cut to the opposite end. If an extensive number of ceramic tiles are shaped by being cut in half, as typically is the case in laying a tile floor or finishing a bathtub/shower stall tile walls, the time savings is significant.

The leeway of MPEP 2173.01 was exercised in the "whereby" clause of the amendment to the claim, but not in the claim recitations of lines 9 to the end, and thus what is

now recited in a positive fashion in claim 1 clearly distinguishes over the '159 patent. More particularly, what is stated in the '159 patent in col. 3, lines 29-35, col. 4, lines 54-68, and in col. 5, lines 11-16, is not anticipatory of the optimally time-accomplished cut-in-two shaping cut of the ceramic tile saw of claim 1.

The unnumbered directional arrow on the support table 57 and the description of the cutting operating mode of the '159 saw as set forth in col. 5, lines 55-68, makes it clear that a duration of cutting a tile in half is the time it takes to urge the blade 33 from one end of the cut to the opposite end, and thus not for the shorter duration as proposed by applicant that results from starting from the center and moving outwardly in opposite directions from the center.

A ground for withdrawing the rejection is found in applying In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed Cir. 1998) and, more particularly, the holding therein that on the issue of anticipation all limitations of a claim must be considered, i.e., the reference to the proposition "the name of the game is the claim," which appears on the cited page of Hiniker.

For the reasons stated, favorable reconsideration of amended claim 1 is respectfully requested.

Respectfully,

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